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FULBRIGHT AND JAWORSKI L L P		CHANG, JUNGWON

ART UNIT	PAPER NUMBER
2154	

FULBRIGHT AND JAWORSKI L L P
PATENT DOCKETING 29TH FLOOR
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LOS ANGELES, CA 900172576

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/752,953	NOH ET AL.
	Examiner	Art Unit
	Jungwon Chang	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *19 March 2001*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-11* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-11* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All b)☐ Some * c)☐ None of:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

U.S. Patent and Trademark Office

DETAILED ACTION

1.   Claims 1-11 are presented for examination.

2.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copies have been filed in parent Application No. 2000-

28612, filed on 5/26/2000, and parent Application No. 2000-353, filed on 1/05/2000.

3.   It is noted that although the claims contain line numbers, the line numbers do not

correspond to the preferred format. The preferred format is to number each line of every

claim, with each claim beginning with line 1. For ease of reference by both the examiner

and applicant all future correspondence should include the recommended line

numbering.

4.   Claim 11 is objected to because of following informalities:

Line 1, "an sender" should be "a sender".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claims 1-3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

>   a.   The terms in the following claims lack proper antecedent basis:
>
>>   i.   the screen – claim 3, line 10;
>>
>>   ii.   the gift coupon providing server – claim 7, lines 11-12;
>
>   b.   The claim language in the following claims is not clearly understood:
>
>>   i.   as to claim 1, line 5, it is uncertain whether the user refers to users
>>
>> in line 2 (i.e., users in line 2 is a plural form, the user in line 5 is a singular
>>
>> form);

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

8.   Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by

Rubstein et al. (US 2003/0061566), hereinafter referred to as Rubstein.

9.   As to claim 8, Rubstein discloses a method for transmitting an email by using a

communication program (i.e., a number of application software, 31, fig. 2; software, 42, fig. 2; GUI, fig. 2; software engine, 48, figs. 3 and 4) installed in a user's computer (fig. 2; fig. 3; page 3, [0031]-[0033]) (i.e., on-line delivery of electronic files; page 1, [0003]; delivering files from one location to another by electronic means; page 1, [0005], [0006]; delivering electronic greeting card, i.e., electronic message, directly to the intended recipient as an attachment to an email; page 1, [0010], lines 11-15; page 4, [0038], lines 12-14), comprising the steps of:

driving the communication program installed in his or her own computer terminal (i.e., executing the computer instructions enables the processor, 34, fig. 2 to retrieve data or write data; page 3, [0031], lines 13-16; software engine, 48 that runs the electronic greeting card, i.e., electronic message; page 3, [0033]) and writing an email message (i.e., the purchaser can personalize the greeting message in the card after downloading the card file...Personalization may involve providing the name of the recipient of the card, and any addition message that the purchaser would like to convey to the recipient; page 4, [0038]);

transmitting the email enclosing a gift coupon given a lottery number (i.e., assigning a unique identification to the electronic greeting card, i.e., electronic message, for purposes such as contest, lucky draw, sweepstakes, and games; page 1, [0013]; awarding a prize for a lottery; page 6, [0055], lines 7-9; winning prize codes may be predefined as the codes are being assigned, e.g., for those games that identifies instant winners; page 6, [0056]) from a sender to a recipient) (i.e., delivering electronic greeting card, i.e., electronic message, directly to the intended recipient as an attachment to an

email; page 1, [0010], lines 11-15; page 4, [0038], lines 12-14; the electronic greeting

card is sent to the recipient from the server as an attachment to an email; page 4,

[0041], lines 14-19);

checking the email (i.e., user execute or open the file; page 6, [0057], line 4) and

accepting receipt of the gift coupon on the recipient's terminal (i.e., the recipient can

download the voucher to redeem the gift; page 5, [0045], lines 9-13; the message may

be structured and configured such that when the user execute or open the file, the

message would pop-up; page 6, [0057]); and

informing the recipient of whether he or she has won a gift (i.e., for a grand

prize winning code, the message may be accompanied with fanfare that would say,

"You are the winner..."; page 6, [0057]).

10.   As to claim 9, Rubstein discloses the communication program is downloaded

from a gift coupon providing server which provides a gift coupon and installed in the

user's computer (i.e., the purchaser (user) downloads the electronic greeting card

executable file (i.e., software to play the file, fig. 6); page 1, [0010], lines 8-10).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1-6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Rubstein et al. (US 2003/0061566), in view of Fortenberry et al. (US

6,336,098), hereinafter referred to as Fortenberry.

13.   As to claim 1, Rubstein discloses the invention substantially as claimed, including

an electronic mail transmitting method in which a server (i.e. server, 10, fig. 1; page 2,

[0029]) provides users (i.e., client, 12, fig. 1) with information (i.e., information such as

advertisement; page 1, [003]) through an electronic mail on the Internet (i.e., Internet,

14, fig. 1; page 2, [0029]) (i.e., on-line delivery of electronic files; page 1, [0003];

delivering files from one location to another by electronic means; page 1, [0005], [0006];

delivering electronic greeting card directly to the intended recipient as an attachment to

an email; page 1, [0010], lines 11-15; page 4, [0038], lines 12-14), comprising the steps

of:

        transmitting an electronic mail (i.e., email) containing information (i.e.,

information such as advertisement; page 1, [003]) plus a gift coupon given a lottery

number (i.e., assigning a unique identification to the electronic greeting card for

purposes such as contest, lucky draw, sweepstakes, and games; page 1, [0013];

awarding a prize for a lottery; page 6, [0055], lines 7-9; winning prize codes may be

predefined as the codes are being assigned, e.g., for those games that identifies instant

winners; page 6, [0056]) to the user (i.e., client, 12, fig. 1) (i.e., delivering electronic

greeting card directly to the intended recipient as an attachment to an email; page 1,

[0010], lines 11-15; page 4, [0038], lines 12-14; the electronic greeting card is sent to

the recipient from the server as an attachment to an email; page 4, [0041], lines 14-19);

checking the electronic mail (i.e., user execute or open the file; page 6, [0057],

line 4) and accepting receipt of the gift coupon on a user's terminal (i.e., the recipient

can download the voucher to redeem the gift; page 5, [0045], lines 9-13; the message

may be structured and configured such that when the user execute or open the file, the

message would pop-up; page 6, [0057]);

storing the information of the user who has accepted receipt of the gift coupon in

a database (i.e., database with recipients, figs. 6 and 7; capturing the information about

recipient, figs. 6 and 7) of a gift coupon providing server (i.e., vendor server; figs. 6 and

7) (i.e., information about the recipient, i.e., who accepts the gift coupon, is saved in a

special area on the server for future matching of prizes; page 6, [0056], lines 32-35);

and

informing the user of whether he or she has won a gift (i.e., for a grand prize

winning code, the message may be accompanied with fanfare that would say, "You are

the winner..."; page 6, [0057]).

14.   Rubstein discloses server (i.e., vendor server; figs. 6 and 7; 10, fig. 1; page 2,

[0029]) doing both transmitting electronic mail (page 1, [0003]; page 1, [0005], [0006];

page 1, [0010], lines 11-15; page 4, [0038], lines 12-14) and storing information of user

in a database of the server (page 6, [0056], lines 32-35). However, Rubstein does not

specifically disclose the information providing server and gift coupon providing server

separately.

15.   Fortenberry discloses information providing server (i.e., E-coupon Distribution Web Site, 34, fig. 2; col. 4, lines 31-52; col. 5, lines 27-41; col. 6, lines 64-66) and gift coupon providing server (i.e., E-coupon Redemption Web Site, 38; col. 5, lines 44-57) are separate one from the other (col. 2, lines 30-31; col. 5, lines 45-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rubstein and Fortenberry because Fortenberry's two separate servers would improve scalability of Fortenberry's system by separately processing different tasks onto the two servers.

16.   As to claim 2, Rubstein discloses wherein said checking the electronic mail and accepting receipt of the gift coupon on a user's computer comprises outputting an advertisement page linked relevant to the gift coupon on a screen of the user's terminal (i.e., display device of the user's terminal, 24, fig. 2, displays a graphical user interface (GUI), 32, fig. 2 for facilitating the display of graphics and text to the user (page 3, [0030]); Executing the computer instructions enables the processor, 34, fig. 2 to display information on the display device, 24, fig. 2; page 3, [0031], lines 13-18); each advertising logo is an executable routine, which when executed would display graphics or audio to represent a company, a product, and a service messages; page 3, [0036], lines 1-5; a web page includes a display of text and graphics, such as an advertising banner that displays images driven by a Java Script or Java Applet; page 1, [0005]).

17.   As to claim 3, it is rejected for the same reasons set forth in claim 1 above. In addition, Rubstein discloses adding a gift coupon list page together with a lottery number (page 1, [0013], [0014]; page 2, [0015], winning prize codes my be predefined as the codes are being assigned; page 6, [0056]) to an e-mail containing information (page 1, [0005]; page 1, [0013]; redeemable gift is dynamically attached to the digital file; page 1, [0014], line 11; page 2, [0015]; page 5, [0045]) and transmitting them from the server to user (page 1, [0003], [0013], [0014]; page 5, [0045]);

reading the gift coupon list page after receiving the e-mail (i.e., the recipient can download the voucher to redeem the gift; page 5, [0045], lines 9-13; the message may be structured and configured such that when the user execute or open the file, the message would pop-up; page 6, [0057]) and selecting his or her desired gift on a user's terminal (i.e., when the purchaser (sender) would be requested to enter the zip code of the recipient so that she will be offered a selection of gifts that are redeemable from the recipient's local store, in addition to other gifts that may be redeemed; page 5, [0045], lines 14-18);

outputting an advertisement page linked to the gift coupon (i.e., advertisement, 54, fig. 3 is dynamically integrated with a digital file, 46, fig. 3...redeemable gift is dynamically attached to the digital file; page 1, [0014]) selected by the user on the screen of the user's terminal (i.e., a web page includes a display of text and graphics, such as an advertising banner that displays images driven by a Java Script or Java Applet; page 1, [0006]; display device of the user's terminal, 24, fig. 2, displays a

graphical user interface (GUI), 32, fig. 2 for facilitating the display of graphics and text to

the user (page 3, [0030]); executing the computer instructions enables the processor,

34, fig. 2 to display information on the display device, 24, fig. 2; page 3, [0031], lines 13-

18); each advertising logo is an executable routine, which when executed would display

graphics or audio to represent a company, a product, and a service messages; page 3,

[0036], lines 1-5).

18.   As to claim 4, it is rejected for the same reasons set forth in claim 1 above. In

addition, Rubstein discloses connecting with a server (i.e. server, 10, fig. 1; page 2,

[0029]) which offers an electronic mail service (i.e., downloading electronic greeting

card (electronic text messages) executable file…delivers the electronic greeting card

directly to the intended recipient as an attachment to an email; page 1, [0010];

electronic greeting card files may be distributed over the Internet; page 3, [0033]) and

writing an e-mail message (i.e., the purchaser can personalize the greeting message in

the card after downloading the card file…Personalization may involve providing the

name of the recipient of the card, and any addition message that the purchaser would

like to convey to the recipient; page 4, [0038]);

transmitting the e-mail enclosing a gift coupon given a lottery number (page 1,

[0013]; page 6, [0055], lines 7-9; page 6, [0056]) from a sender (i.e., purchaser) who

has written the e-mail message to a recipient (i.e., delivering the message directly to the

intended recipient as an attachment to an email; page 1, [0010], lines 11-15; purchaser

delivers the message to the recipient as an attached file to an email; page 4, [0038],

lines 12-14; page 1, [003]; page 1, [0005]; page 4, [0038], lines 12-14).

19. Rubstein discloses server (i.e., vendor server; figs. 6 and 7; 10, fig. 1; page 2, [0029]), which offers an electronic mail service (page 1, [0005]; electronic files transmitted over a network; page 1, [0006], [0010]; page 3, [0033]). However, Rubstein does not specifically use a term "web server". Fortenberry discloses a web server (col. 4, lines 31-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rubstein and Fortenberry because Fortenberry's web server would increase the capacity of Rubstein's system by adding the functionality of web server, thereby efficiently responding to the request received from the client and transmitting the requested data to the requesting client.

20. As to claim 5, Rubstein discloses outputting (i.e., display device of the user's terminal, 24, fig. 2, displays a graphical user interface (GUI), 32, fig. 2 for facilitating the display of graphics and text to the user page 3, [0030]; display information on the display device, 24, fig. 2; page 3, [0031], lines 13-18) a gift coupon list page containing banner advertisements (i.e., advertisement is dynamically integrated with a digital file...a redeemable gift is dynamically attached to the digital file; page 1, [0014]) with various gift menus on the screen of the sender's terminal in case that the sender selects the button for sending the e-mail together with the gift coupon (i.e., the purchaser (sender) clicks on the text or graphics link on a web page and the link/request is established to the server, 10, fig. 4...the purchaser may be given a menu of options for

various categories of occasions. The menu may comprises "hot" or "clickable" buttons or graphic links for user selection; page 3, [0037]; based on purchaser's selection, a gift certificate or a voucher for a particular product may be attached to the greeting card as a gift, e.g., voucher is included in the greeting card file, 46, fig. 3; page 5, [0045]; a web page includes a display of text and graphics, such as an advertising banner that displays images driven by a Java Script or Java Applet; page 1, [0006]); and

outputting an advertising document corresponding to the banner advertisement on the screen of the sender's terminal when the sender selects one of the banner advertisements arranged in the gift coupon list page (i.e., a web page includes a display of text and graphics, such as an advertising banner that displays images driven by a Java Script or Java Applet; page 1, [0006]; advertisements, 54, fig. 4 which may be in form of a logo, a banner and other forms of advertisement display; page 3, [0035], lines 23-25).

21.   As to claim 6, Rubstein discloses the checking the email and accepting receipt of the gift coupon on a recipient's terminal comprises outputting (i.e., display device of the user's terminal, 24, fig. 2, displays a graphical user interface (GUI), 32, fig. 2 for facilitating the display of graphics and text to the user page 3, [0030]; display information on the display device, 24, fig. 2; page 3, [0031], lines 13-18) an advertisement page linked relevant to the gift coupon on the screen of the recipient's terminal (i.e., a link to the vendor's server (gift coupon providing server) on which the customized card (figs. 3 and 4) resides is sent to the recipient in an email. The recipient

can download a copy of the card by invoking the link in the email message; page 4,

[0041], lines 14-19).

22.   As to claim 10, it is rejected for the same reasons set forth in claim 1 above. In

addition, Rubstein discloses a client computer (i.e., client, 12, fig. 1; fig. 2; page 2,

[0029]; page 3, [0031]); and the client computer and servers are connected through the

Internet (fig. 1; page 2, [0029]).

23.   As to claim 11, it is rejected for the same reasons set forth in claim 4 above. In

addition, Rubstein discloses a plurality of client computers used by a sender of an e-

mail and its recipient (i.e., client, 12, fig. 1; fig. 2; page 2, [0029]; page 3, [0031]); and

the client computer and servers are connected through the Internet (fig. 1; page 2,

[0029]).

24.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubstein

et al. (US 2003/0061566), Fortenberry et al. (US 6,336,098), further in view of Boal

(2004/0030598).

25.   As to claim 7, it is rejected for the same reasons set forth in claim 4 above. In

addition, Rubstein outputting (i.e., display device of the user's terminal, 24, fig. 2,

displays a graphical user interface (GUI), 32, fig. 2 for facilitating the display of graphics

and text to the user page 3, [0030]; display information on the display device, 24, fig. 2;

page 3, [0031], lines 13-18) an advertisement page linked relevant to the gift coupon on the screen of the recipient's terminal (i.e., a link to the vendor's server (gift coupon providing server) on which the customized card (figs. 3 and 4) resides is sent to the recipient in an email. The recipient can download a copy of the card by invoking the link in the email message; page 4, [0041], lines 14-19).

26.   Rubstein discloses reading the gift coupon page on the recipient's terminal (i.e., the recipient can download the voucher to redeem the gift; page 5, [0045], lines 9-13; execute or open the file, the message would pop-up; page 6, [0057]) and selecting his or her desired gift on the sender's terminal (i.e., purchaser (sender) may be given a menu for various categories of occasions...the menu may comprise "hot" or "clickable" buttons or graphic links for user selection; page 3, [0037]; page 5, [0045], lines 1-9). However, Rubstein Fortenberry do not specifically disclose that desired gift is selected on the recipient's terminal.

27.   Boal discloses selecting his or her desired gift on the recipient's terminal (i.e., the second main group of information included in user preference data, 32, fig. 1 includes a comprehensive listing of main categories of coupons selected by the user that the user wishes to receive; page 4, [0046]; the user may select an item from coupons list, 70, fig. 3A, which will then be displayed in coupon display area, 76, fig. 3A; page 5, [0061]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rubstein, Fortenberry and Boal because Boal's

selecting desired gift by the recipient would improve the electronic marketing service by allowing the recipient to select the desired coupon that he wishes to redeem.

Conclusion

28.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Laor, patent 6,584,448, Kepecs, patent 6,330,543, Laor, patent 6,076,069 disclose method and system for distributing and redeeming electronic coupons in a computer network environment.

Cairns, patent 6,173,267, Schwartz et al, Pub. No. US 2002/0165766 disclose method and system for electronic promotional offer in relation to product or service with contests or sweepstakes, and notifying the user of offer match.

Soobok Lee, WO 00/58882, Jin-Yong Joo, WO 00/42747 disclose advertising method using an email.

29.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is (703)305- · 9669. The examiner can normally be reached on 9:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWC
October 13, 2004